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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NICK NYHAN, and RONIT AVIV

Appeal No. 2009-012680
Application No. 09/900,674
Technology Center 3600

Oral Hearing Held: June 9, 2010

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

APPEARANCES:

ON BEHALF OF THE APPELLANT:

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1 The above-entitled matter came on for hearing on Wednesday, June 9,
2 2010, commencing at 1:01 p.m., at the U.S. Patent and Trademark Office,
3 600 Dulany Street, Alexandria, Virginia, before Paula Lowery, Notary
4 Public.

5 JUDGE CRAWFORD: This is the Board of Patent Appeals and
6 Interferences.

7 MR. JOY: Good afternoon, this is Mark Joy.

8 JUDGE CRAWFORD: Hello. You are in Hearing Room A before Judges
9 Crawford, Fetting and Fischetti. You can begin whenever you're ready.

10 MR. JOY: Honorable members of the Board, my name is Mark Joy, and my
11 registration number is 35562. I represent the Appellant Nyhan, et al. and the
12 assignee, Dynamic Logics in the present Appeal of U.S. Application No. 09-
13 900,674 that was filed on July 6, 2001.

14 JUDGE CRAWFORD: Mr. Joy, can I interrupt you for a moment? Can you
15 spell you name for the court reporter?

16 MR. JOY: Absolutely, M-a-r-k, J-o-y.

17 JUDGE CRAWFORD: Go ahead.

18 MR. JOY: Members of the Board, I believe the Appellant's Briefs are clear
19 with regard to what we believe to be the shortcomings of the current
20 rejection; and, in particular, the final office action.

21 There's a fundamental difference, I think, of opinion between what is meant
22 by a solicitation to take a survey and an online survey itself.

23 In general, I believe that point has filtered through the analysis over the last
24 couple of office actions and in the Briefs. I believe that that's the primary
25 issue that needs to be resolved here on appeal.

1 As I said before, I believe the Briefs are pretty clear, and I wouldn't want to
2 just repeat everything that's made because there are a lot of points that are
3 made. My primary purpose in requesting this oral hearing is to make sure
4 that if there's any questions that the Board has, with regard to any points of
5 the Appellant, that I do my best to answer those today.

6 JUDGE FISCHETTI: We have a question about the definition of a
7 solicitation versus actual.

8 MR. JOY: Right.

9 JUDGE FISCHETTI: Do you find there's a difference between an invitation
10 for a survey and a solicitation for a survey?

11 MR. JOY: I can answer that, absolutely. In fact, in our own specification,
12 we distinguish between the two. Moreover, Dement, which is the secondary
13 reference, distinguishes between the two.

14 It has a very important difference. In fact, you can see in Claim 1 the
15 invention isn't directed to limiting how often surveys are presented to users.
16 Instead -- and hopefully the client isn't angry at me for saying this -- it's the
17 annoying pop-ups that people get.

18 If you use the Internet with any relative use, it's almost impossible to go a
19 session without, you know -- on Yahoo or some other site -- without having
20 a solicitation to take a survey pop up. What this invention does is it limits
21 how often those pop-ups come drifting across your screen.

22 If you take a look at the cited references of Smith and Dement, they aren't
23 even addressing that issue. Instead, they're addressing the issue of limiting
24 how many times a person actually takes a survey, because you don't want a
25 survey analysis contaminated by people who have done it, you know, a

1 hundred times, which would be contrary to what the intent of the survey
2 was.
3 This invention is directed to limiting how often you get those pop-ups going
4 on your screen that are saying would you like to take a survey.
5 As I mentioned, Dement specifically identifies it in Column 3, lines 25
6 onward; and that distinguishes between the presentation. That discusses the
7 presentation of an invitation to take a survey, and later on, actually in
8 Column 4, they talk about beginning -- I want to make sure I get this right.
9 It's Step 216, which is at Line 47.
10 It says: "The decision of Step 216 determines whether or not the user has
11 seen the particular survey within the last six months." That's as opposed to
12 what they discussed in Column 3, beginning at Line 25, which is the
13 presentation of a pop-up to invite a user to take a survey.
14 JUDGE FISCHETTI: So, basically, under Dement if the pop-up was seen
15 within the last six months, it's not going to pop-up.
16 MR. JOY: Actually, no, that's not true. That same decision, Step 216, talks
17 about whether or not -- it records when a person has completed the survey.
18 JUDGE FISCHETTI: Okay.
19 MR. JOY: So all that Dement knows is when a user is past his picking that
20 actual survey.
21 As I mentioned, imagine the user that always says, no, I don't want to take a
22 survey. In the old way under Smith and Dement, they keep getting this
23 invitation to take it over and over again, and they have no interest in taking
24 it. That's what our invention is tracking to.

1 Dement would only record the situation when the person had actually
2 completed the survey, and that's what's discussed at Step 216 at Column 4,
3 Line 47 onward.

4 JUDGE FISCHETTI: Smith reference in Paragraph 129 -- it talks about
5 curtailing the ability of the user to take a survey, if that survey has already
6 been noted as taken.

7 MR. JOY: That's right.

8 JUDGE FISCHETTI: So there appears to be a teaching at least of curtailing
9 a survey -- albeit initiated by the user, but still curtailing a survey after a
10 given number, e.g. one, has been made of that survey.

11 MR. JOY: Curtailing of the taking of them, that is true. I see that as a
12 fundamental difference between the two. That's just a starting point.

13 Of course, there's other points I have in the Brief that address other issues,
14 but with regards to that, I think there's a huge difference between those two
15 things.

16 One is directed to trying to prevent -- to maintain the veracity of the survey
17 itself, while another allows -- the claimed invention is actually directed to
18 saving the users of the Internet from getting those annoying pop-ups.

19 I say Dement and Smith have no qualms with annoying the user with
20 repeated invitations to take a survey. What they're interested in is protecting
21 the analysis of the survey afterwards.

22 JUDGE FISCHETTI: What I still have a fundamental issue with is the fact
23 that Smith has a teaching for a limit of viewing of a survey. Would that not
24 stop the perpetual presentation of invitations once that one survey was seen?

1 MR. JOY: Actually, in Smith, no, it wouldn't because Smith doesn't do
2 anything initially -- it downloads a banner ad with the actual web page, so
3 there's no way to prevent the actual initial solicitation.

4 The survey is actually downloaded with the initial page in Smith. If the user
5 decides they want to take the survey and click on the banner ad, it's already
6 been downloaded.

7 So I'm not using the specific example, but what would actually occur is an
8 invitation to take a survey would repeatedly download. Smith has nothing to
9 do with limiting the survey presentation -- I'm sorry, the survey solicitation.

10 JUDGE CRAWFORD: Even if the survey had already been taken?

11 MR. JOY: If it's already been taken, you would still get the banner ad.
12 What would happen is after a user -- in the case of Smith, after the user
13 clicked on that link, logic would be executed and they would present the
14 presentation of the survey. But the actual invitation comes with the page,
15 regardless of whether the user has taken the survey before or not.

16 JUDGE CRAWFORD: So are you saying the difference is that your
17 invention prevents solicitation and the prior art prevents surveys?

18 MR. JOY: At a high level, that's true; but, of course, there's a lot more to the
19 claim than that. You know, a specific ordering of steps that occurs, the
20 delivery method, the computers that are involved differ from what Smith and
21 Dement disclose.

22 That's in the details of our briefing and probably beyond what I could go into
23 in any detail today, but I could answer specific questions if necessary.

24 JUDGE FISCHETTI: Where does Smith say that once the first survey was
25 taken and the cookie is founded that there would be a subsequent need for an
26 invitation or solicitation, so long as the survey would be foreclosed?

1 MR. JOY: In Paragraph 58 of Smith, they describe the delivery mechanism
2 for the invitations to take the surveys. About midway in that paragraph 0058
3 it says: "contained within the set of web pages are banners," then it lists
4 numbers, "which may also be defined using a variety of methods and
5 formats," as indicated by the dashed lines.

6 The banners 270 and 272 contain hypertext links to surveys, 258 and 260.
7 By selecting a banner a network user client is automatically provided with a
8 corresponding survey."

9 JUDGE FISCHETTI: All right.

10 MR. JOY: So as described in Smith, Paragraph 58, the web page has
11 banners on it and banners the invitation to take the survey. When the user
12 selects the banner itself, the link is activated, and the survey is downloaded.
13 Then later on they describe in the case where a user has already taken a
14 survey, a cookie would indicate that. In that instance the survey would be
15 prevented.

16 JUDGE FISCHETTI: The rejection is made in the combination with
17 Dement --

18 MR. JOY: Right.

19 JUDGE FISCHETTI: -- which is an invitation based. So the Examiner
20 made the combination with the understanding that one of ordinary skill in
21 the art would know to use an invitation as a precursor to the automatic
22 presentation of the survey.

23 MR. JOY: Actually, I believe he referred to Dement for the teaching of a
24 time stamp because Smith didn't identify any time stamp.

25 I can go on and tell you something about Dement. Actually, Dement again,
26 as I mentioned earlier in this discussion, Dement will only record that a user

1 has completed a survey. It does not record that a person was solicited to
2 take a survey. That's described --

3 JUDGE FISCHETTI: But doesn't that occur automatically? If you've taken
4 one, you've been recorded as being solicited for it.

5 MR. JOY: It would not identify past solicitations. It would only identify
6 that a user had taken the survey. I believe the language of the claims itself
7 would distinguish that situation. You're correct, the person could not take a
8 survey without having previously solicited to take a survey. That is
9 absolutely true.

10 But I believe the claims are appropriately worded to point out that what's
11 recorded in the time stamp and testing and execution of software is based
12 upon the solicitation and not based upon the taking.

13 JUDGE CRAWFORD: Can you direct us to the exact language in Claim 1?

14 MR. JOY: I think it's easier if it's read in complete -- you know, all of the
15 references.

16 JUDGE CRAWFORD: Okay.

17 MR. JOY: The key is, I'd say, in preparing today one of the most important
18 things is the part that says -- it's part of the providing step. "The block of
19 data further including additional computer-readable instructions that
20 facilitate decision-making steps for determining whether to present an online
21 survey solicitation via the browser client and the assessing step, which says
22 that accessing on the user computer a time-stamp value indicative of a
23 period of time that has passed since the online survey solicitation was
24 previously presented."

25 If all you had to go with was the stamp on a -- the time stamp on when a
26 person took a survey, you'd have no idea how long it had been since the

1 survey solicitation had been downloaded and presented to a user.

2 In other words, if you have any experience with the use of the Internet and
3 sites like Yahoo, which are pretty regular in their downloading of
4 solicitations, solicitations occur quite often.

5 There's no way that you could equate a time stamp on taking a survey with
6 solicitations. There can be many denials by a user of the solicitation to take
7 a survey that occur after.

8 JUDGE FISCHETTI: So we understand the Examiner only used Dement for
9 limited purposes, but my question to you is: aside from that, one skilled in
10 the art looking at Dement and seeing that there is a precursor step of
11 invitation based on a determination process, why wouldn't one skilled in the
12 art make that modification to Smith?

13 MR. JOY: We read Smith and Dement -- getting back to the fundamental
14 point, both of those are teaching people ways to prevent users who might be
15 getting \$10 for every survey they're taking -- it's meant to protect the survey
16 taker.

17 This invention is about protecting the person who's solicited to take the
18 survey. Neither of these references even touches on that concern or a
19 solution to it. Unless a user takes a survey, they aren't protected from
20 any subsequent annoying pop-ups.

21 The other point is that Smith is actually meant to prevent people from taking
22 one again ever. So, you know, the concept of a time stamp doesn't even
23 come into play with Smith because Smith is basically saying once a user has
24 taken a survey, we don't want them to ever take it again.

25 JUDGE FISCHETTI: It seems to be trending a little toward
26 your goal which is to keep those annoyances away from the user.

1 MR. JOY: Right, but the whole invention and some of the dependent claims
2 are meant to say that a certain level is -- there was a lot of thought that went
3 into this by the inventors. You know, not only -- it's not an absolute. You
4 know, once you've been shown a survey, never show that survey to the
5 person again.

6 One, they introduced the time stamp. In dependent claims they introduced
7 the idea of frequency. They start off not giving it to a person over and over
8 again as one of the dependent claims specifically argued.

9 What they do is they get closer to the time when they have to have the
10 results, they start allowing these solicitations to occur more frequently; but
11 early on, they don't.

12 This is really an invention that's directed toward protecting the consumer,
13 and I don't believe Smith or Dement had any interest in doing that; and as a
14 result, didn't put any type of disclosure in that addressed the user experience
15 and the annoyances of getting these pop-ups over and over again.

16 The only way you can prevent a pop-up coming over and over again with
17 Dement and Smith is to take the actual survey itself.

18 JUDGE CRAWFORD: Any more questions?

19 JUDGE FISCHETTI: No.

20 JUDGE FETTING: No.

21 JUDGE CRAWFORD: All right, that's all we have. Thank you.

22 MR. JOY: Thank you very much, I appreciate your questions. have a nice
23 afternoon.

24 Whereupon, the proceedings at 1:23 p.m. were concluded.